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09/388,935	09/02/1999	TADAMITSU MIYAWAKI	104144	4667

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EXAMINER
HAYES, JOHN W

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 09/388,935	Applicant(s) JACOBS ET AL.
	Examiner John W Hayes	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _06 March 2002_ .

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-15_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _02 September 1999_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

       1.☒ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____ .

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)		4)☐ Interview Summary (PTO-413) Paper No(s). _____ .	
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)		5)☐ Notice of Informal Patent Application (PTO-152)	
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .		6)☐ Other: .	

DETAILED ACTION

Drawings

1.   The drawings filed on 02 September 1999 are objected to and subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

2.   Applicant indicated in the amendment filed 06 March 2002 that new formal drawings have been submitted. Examiner notes that these drawings have not yet been received and, therefore, the above noted objections remain outstanding.

Response to Arguments

3.   Applicant's arguments filed 06 March 2002 have been fully considered but they are not persuasive.

4.   Applicant argues that Dillon fails to disclose selecting by a user at least one of the encrypted content from the distributed contents and decoding the encrypted content for utilization by the user. Examiner submits that Dillon discloses distributing a catalog of available documents to the users wherein users select from the catalog which content they wish to receive. The contents are then encrypted and distributed to the user and the user is billed for using the content. Examiner agrees that not all the available content is encrypted and distributed to the user wherein the user can then select the contents he/she wishes to view. Dillon distributes only a catalog of available content so that the user device is not required to receive contents that the user may not be interested in. Examiner submits that this would have been obvious in view of the reference to Dillon, especially since Dillon indicates that the use of a catalog presents a convenient method for a user to determine which documents to receive and allows the user to completely control which documents are received and thus prevents wasting resources on the

reception of documents not of interest (Col. 11 line 65-Col. 12 line 5). Thus, the rejection of the claims

has been changed and is included below for applicant's convenience.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections

set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1, 5-7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon, U.S.

Patent No. 5,727,065.

        As per **Claim 1**, Dillon discloses a contents distribution method for distributing digitized contents

to plural users comprising:

-    encrypting and distributing contents to plural users (Col. 1 line 65-Col. 2 line 7; Col. 6, lines

     57-62),

-    selecting by a user at least one of the encrypted content from a catalog (Col. 4, lines 5-20)

-    decoding the encrypted contents and utilizing thereof by a user (Col. 2, lines 10-15; Col. 4,

     lines 12-18; Col. 6, lines 60-67; Col. 9 line 65-Col. 10 line 6), and

-    executing accounting to the user according to said utilized contents (Col. 4, lines 15-20; Col.

     5, lines 43-50; Col. 6, lines 19-24; Col. 7, lines 26-38; Col. 8, lines 28-43).

Dillon, however, fails to explicitly disclose that the encrypted contents are first distributed to users and

wherein the users can then select at least one of the encrypted content from the distributed contents.

Dillon discloses that a catalog of available contents is distributed to the plural users and further wherein

the users can then select the content that they wish to receive. However, It would have been obvious to

one of ordinary skill in the art at the time of applicant's invention to modify the method of Dillon and

distribute the available contents to the user and further allow the user to select the contents he/she is

interested in after reception of the contents. Dillon teaches that this method is not necessary since it

would waste resources by requiring the user to receive content not of interest. The motivation would be

to allow the user to determine which content he/she wishes to receive and charging the user for only the

content that he/she receives without wasting resources by requiring the user to receive content not of

interest (Col. 11 line 65-Col. 12 line 5).

As per **Claim 5**, Dillon further discloses wherein the contents mean a document displayed in a

page unit (Col. 1, lines 55-65) and wherein the accounting is executed for the page unit (Col. 4, lines 16-

20; Col. 7, lines 26-30).

As per **Claim 6**, Dillon further discloses wherein the distribution is executed by broadcast (Figure

1; Col. 3, lines 40-45).

As per **Claim 7**, Dillon discloses a contents distribution system that distributes digitized contents

to plural users comprising:

-   a distribution device that distributes encrypted contents (Figure 1; Col. 4, lines 1-20),

-   a user terminal that receives encrypted contents distributed by the distribution device (Figure

    1; Col. 4, lines 12-18; Col. 6, lines 60-67; Col. 9 line 65-Col. 10 line 6), selects at least one

    encrypted content from a catalog (Col. 4, lines 5-20) and generates accounting information

    according to the utilization of the selected encrypted content (Col. 4, lines 15-20; Col. 5, lines

    43-50; Col. 6, lines 19-24; Col. 7, lines 26-38; Col. 8, lines 28-43), and

-   a central station that collects and totalizes accounting information generated by the user

    terminal (Col. 4, lines 15-20; Col. 7, lines 26-38; Col. 8, lines 28-43).

Dillon, however, fails to explicitly disclose that the encrypted contents are first distributed to users and

wherein the users can then select at least one of the encrypted content from the distributed contents.

Dillon discloses that a catalog of available contents is distributed to the plural users and further wherein

the users can then select the content that they wish to receive. However, It would have been obvious to

one of ordinary skill in the art at the time of applicant's invention to modify the method of Dillon and

distribute the available contents to the user and further allow the user to select the contents he/she is

interested in after reception of the contents. Dillon teaches that this method is not necessary since it

would waste resources by requiring the user to receive content not of interest. The motivation would be

to allow the user to determine which content he/she wishes to receive and charging the user for only the

content that he/she receives without wasting resources by requiring the user to receive content not of

interest (Col. 11 line 65-Col. 12 line 5).

As per **Claim 11**, Dillon further discloses wherein the distribution is executed by broadcast

(Figure 1; Col. 3, lines 40-45).

7.   Claims 2-4, 8-10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon, U.S.

Patent No. 5,727,065 in view of Downs et al, U.S. Patent No. 6,226,618 B1.

As per **Claim 2**, Dillon discloses a contents distribution method including summary information

showing a summary of the available contents (Col. 4, lines 5-7 and 53-60; Col. 6, lines 12-24 and 35-41),

however, fails to specifically disclose that the summary information is attached to the encrypted contents.

Dillon teaches that the summary data is transmitted separately from the content data. Downs et al

disclose an electronic content delivery system for providing digital content in secure containers to a

plurality of users and further teach that summary information (Col. 9, lines 21-32) is included in the

encrypted contents container (Col. 38 line 21-Col. 39 line 20). It would have been obvious to one of

ordinary skill in the art to modify the method of Dillon and include summary data attached to the

encrypted content data in view of the teachings of Downs et al. One would have been motivated to

include summary data with the content so that the user could refer to the summary data before

purchasing the content to decide whether or not he/she desires the content. Dillon provides motivation by

indicating that summary data is included such as a description of the content which would be sufficient to

allow a user to determine whether he/she desires the document (Col. 6, lines 17-20).

As per **Claim 3**, Dillion discloses a contents distribution method including summary information

showing a summary of the available contents (Col. 4, lines 5-7 and 53-60; Col. 6, lines 12-24 and 35-41),

however, fails to specifically disclose that the summary information is attached to the encrypted contents

and displayed only in case it is accompanied by decoding information for decoding encrypted contents

corresponding to the summary information. Dillon teaches that the summary data is transmitted

separately from the content data and in unencrypted form. Downs et al disclose an electronic content

delivery system for providing digital content in secure containers to a plurality of users and further teach

that summary information (Col. 9, lines 21-32) is included in the encrypted contents container (Col. 38 line

21-Col. 39 line 20) and wherein the summary information is not displayed unless it has been decrypted

using the decryption information (Col. 73, lines 12-40; Col. 74, lines 25-34). It would have been obvious

to one of ordinary skill in the art to modify the method of Dillon and include the summary information in

encrypted form along with the encrypted content information in a secure container and only displaying this

information upon decryption of the secure container in view of the teachings of Downs et al. Downs et al

provides motivation for encrypting the summary information so that it can be protected in the case where

the content provider wants to charge a fee for the summary information (Col. 73, lines 33-40).

As per **Claim 4**, Dillon discloses a contents distribution method including decoding of the

encrypted contents before gaining access, however, Dillon fails to specifically disclose wherein the

decoding is executed by a decoding key generated based upon first decoding information attached to the

encrypted contents and second decoding information which is provided to the user. Downs et al disclose

an electronic content delivery system for providing digital content in secure containers to a plurality of

users and further teach encrypting/decrypting the secure container by executing a decoding technique

wherein a decoding key is generated based upon first decoding information attached to the encrypted

contents and second decoding information which is provided to the user (Col. 16, lines 21-53). It would

have been obvious to one of ordinary skill in the art to modify the method of Dillon and include a process

of decrypting the encrypted content through the use of a decoding key which is generated based upon

decoding information attached to the encrypted contents and decoding information which is provided to

the user as taught by Downs et al. For example, Downs et al teaches a method to secure the distributed

content wherein the sender encrypts a symmetric key with the recipient's public key and this information

is transmitted along with the content. Downs et al further teaches that the recipient uses their private key

to decrypt the encrypted symmetric key which is then used to decrypt the encrypted content. Therefore,

the decoding key (symmetric key) for decoding the encrypted content data is generated based upon

decoding information attached to the content (recipient's public key) and decoding information provided to

the user (recipient's private key). The well known motivation for using this type of encryption would be to

secure the transmission of the content so that only authorized users are permitted to view the content.

As per **Claim 8**, Dillon discloses a contents distribution method including summary information

showing a list and a summary of the available contents (Col. 4, lines 5-7 and 53-60; Col. 6, lines 12-24

and 35-41), however, fails to specifically disclose that the list and summary information is attached to the

encrypted contents. Dillon teaches that the list and summary data is transmitted separately from the

content data. Downs et al disclose an electronic content delivery system for providing digital content in

secure containers to a plurality of users and further teach that list and summary information (Col. 9, lines

21-32) is included in the encrypted contents container (Col. 38 line 21-Col. 39 line 20). It would have

been obvious to one of ordinary skill in the art to modify the method of Dillon and include list and

summary data attached to the encrypted content data in view of the teachings of Downs et al. One would

have been motivated to include summary data with the content so that the user could refer to the list and

summary data before purchasing the content to decide whether or not he/she desires the content. Dillon

provides motivation by indicating that summary data is included such as a description of the content

which would be sufficient to allow a user to determine whether he/she desires the document (Col. 6, lines

17-20).

As per **Claim 9**, Dillon further discloses wherein the user terminal displays list information and summary information (Col. 4, lines 5-7 and 53-60; Col. 6, lines 12-24 and 35-41) and the user terminal decodes only encrypted contents selected by a user based upon the displayed list information and summary information out of encrypted contents received (See col. 6, lines 45-55)

As per **Claim 10**, Dillion discloses a contents distribution method including list and summary information of the available contents (Col. 4, lines 5-7 and 53-60; Col. 6, lines 12-24 and 35-41), however, fails to specifically disclose that the summary information is attached to the encrypted contents and displayed only in case it is accompanied by decoding information for decoding encrypted contents corresponding to the summary information. Dillon teaches that the list and summary data is transmitted separately from the content data and in unencrypted form. Downs et al disclose an electronic content delivery system for providing digital content in secure containers to a plurality of users and further teach that list and summary information (Col. 9, lines 21-32) is included in the encrypted contents container (Col. 38 line 21-Col. 39 line 20) and wherein the summary information is not displayed unless it has been decrypted using the decryption information (Col. 73, lines 12-40; Col. 74, lines 25-34). It would have been obvious to one of ordinary skill in the art to modify the method of Dillon and include the list and summary information in encrypted form along with the encrypted content information in a secure container and only displaying this information upon decryption of the secure container in view of the teachings of Downs et al. Downs et al provides motivation for encrypting the summary information so that it can be protected in the case where the content provider wants to charge a fee for the summary information (Col. 73, lines 33-40).

As per **Claim 15**, Dillon discloses a contents distribution method wherein the distribution device attaches first decoding information required for decoding the encrypted contents to the encrypted contents and distributes them (Col. 6, lines 42-49), however, Dillon fails to specifically disclose wherein the user terminal is provided with second decoding information proper to the user and wherein the user decodes the encrypted contents based upon the first and second decoding information. Downs et al

disclose an electronic content delivery system for providing digital content in secure containers to a

plurality of users and further teach encrypting/decrypting the secure container by executing a decoding

technique wherein a decoding key is generated based upon first decoding information attached to the

encrypted contents and second decoding information which is provided to the user (Col. 16, lines 21-53).

It would have been obvious to one of ordinary skill in the art to modify the method of Dillon and include a

process of decrypting the encrypted content based upon decoding information attached to the encrypted

contents and decoding information which is proper to the user as taught by Downs et al. For example,

Downs et al teaches a method to secure the distributed content wherein the sender encrypts a symmetric

key with the recipient's public key and this information is transmitted along with the content. Downs et al

further teaches that the recipient uses their private key to decrypt the encrypted symmetric key which is

then used to decrypt the encrypted content. Therefore, the decoding key (symmetric key) for decoding

the encrypted content data is generated based upon decoding information attached to the content

(recipient's public key) and decoding information proper to the user (recipient's private key). The well

known motivation for using this type of encryption would be to secure the transmission of the content so

that only authorized users are permitted to view the content.

8.   Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon, U.S. Patent No.

5,727,065 in view of Stefik et al, U.S. Patent No. 5,634,012.

As per **Claims 12 and 13**, Dillon discloses a contents distribution system wherein the user

terminal comprises:

-   a data sink that receives encrypted contents distributed from the distribution device (Col. 2,

    lines 10-15; Col. 6, lines 60-65),

-   a data output part that decodes the encrypted contents (Col. 2, lines 10-15; Col. 4, lines 15-

    20; Col. 6 line 64-Col. 7 line 5) and generates accounting information according to the

    quantity of utilized decoded contents (Col. 4, lines 15-20; Col. 5, lines 43-50; Col. 6, lines 19-

    24; Col. 7, lines 26-38; Col. 8, lines 28-43)

Dillon fails to specifically disclose that the user terminal stores the encrypted contents distributed from the distribution device, but discloses that the user terminal decrypts the encrypted content as it is being received and only stores the decrypted contents. However, it would have been obvious to one of ordinary skill in the art to modify this method and receive and store the content in its encrypted form and then decrypt the content after it has been stored. The motivation would be to provide a faster and more efficient transmission technique since the content would not need to be decrypted in real time as it is being received, but rather decrypted only when the user is ready to view the information.

Dillon further fails to specifically disclose a printer that prints the contents. Stefik et al disclose a system for controlling the distribution and use of digital information and teach wherein a printer is used to print a certain number of copies of the decoded information (Col. 38, lines 21-62) and performs closing transaction steps including initiating a charging transaction based upon the quantity of the utilized contents (Col. 33, lines 48-59). It would have been obvious to one of ordinary skill in the art to modify the method of Dillon and incorporate the ability to not only display the decoded content, but also print the decoded content and charge a fee for printing of the document as taught by Stefik et al. The motivation would be to provide the convenience to the user of having the ability to render the digital content by using a printer so that it could be carried in hardcopy form. It also would provide a benefit to the content provider by allowing the content provider to charge a fee for printing the content as taught by Stefik et al.

As per **Claim 14**, Dillon discloses a contents distribution system wherein the user terminal comprises:

- a data sink that receives encrypted contents distributed from the distribution device (Col. 2, lines 10-15; Col. 6, lines 60-65),

- a display that decodes the encrypted contents and displays the contents (Col. 1, lines 60-65; Col. 2, lines 10-15; Col. 4, lines 15-20; Col. 6 line 64-Col. 7 line 5) and generates accounting information according to the quantity of utilized decoded contents (Col. 4, lines 15-20; Col. 5, lines 43-50; Col. 6, lines 19-24; Col. 7, lines 26-38; Col. 8, lines 28-43)

Dillon fails to specifically disclose that the user terminal stores the encrypted contents distributed from the distribution device, but discloses that the user terminal decrypts the encrypted content as it is being received and only stores the decrypted contents. However, it would have been obvious to one of ordinary skill in the art to modify this method and receive and store the content in its encrypted form and then decrypt the content after it has been stored. The motivation would be to provide a faster and more efficient transmission technique since the content would not need to be decrypted in real time as it is being received, but rather decrypted only when the user is ready to view the information.

Dillon also discloses that the content includes text, software, images and full-motion video, however, further fails to specifically disclose displaying the contents and generating accounting information specifically according to the number of pages included in the displayed contents. Stefik et al disclose a system for controlling the distribution and use of digital information and teach wherein the user device is used to display the digital contents such as rendering it for reading (Col. 37, lines 60-67) and performs closing transaction steps including initiating a charging transaction based upon the quantity of the utilized contents (Col. 38, lines 19-21; Col. 33, lines 48-59). It would have been obvious to one of ordinary skill in the art to modify the method of Dillon and incorporate the ability to not only display the decoded content, but also print the decoded content and charge a fee for displaying or printing of the document based upon the number of pages in the content as taught by Stefik et al. The motivation would be to permit the user to display the received content thereby making it useful. It also would provide a benefit to the content provider by allowing the content provider to charge a fee for displaying the content as taught by Stefik et al.

Conclusion

9.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date

of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX

MONTHS from the date of this final action.

10. The prior art previously made of record and not relied upon is considered pertinent to applicant's

disclosure.

o Saito discloses a secure data broadcasting system wherein encrypted content is broadcast to users

that decode the information

o Kazmierczak et al disclose a cryptographic system for effecting metered purchases of encrypted data

for a local encrypted database

o Peterson, Jr. discloses a system for distribution of secured content wherein the user decrypts the

content and is available for viewing during a certain timeframe

o Ginter et al disclose a system and method for secure transaction management wherein content is

distributed to users and assigned certain rights for accessing the data

o Choy discloses the distribution of content to users wherein a protection specification including

information for controlling the use of the content is attached to the content and transported together

o Kocher et al disclose a secure cryptographic rights unit for cryptographically regulating access to digital

content distributed over a network

o WO 90/02382 discloses an information distribution system that provides encrypted information to a

user that corresponds to criteria individually selected by the user and then charges the user only for the

selected information provided

o Thyfault, Mary E., "Data From Above", discloses a satellite service that broadcasts encrypted

information to users and are charged for the amount of information downloaded.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-7239 (for formal communications intended for entry).

The Fax phone number for **AFTER-FINAL** communications where this application or proceeding is assigned in (703) 746-7238.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

John Hayes

Examiner

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

08 May 2002